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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,322	01/09/2001	Chetan Shah	TAL/8003.001	5492

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EXAMINER	
OUELLETTE, JONATHAN P	
ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,322

Applicant(s)

SHAH ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2001 and 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 101 and 35 USC § 112

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts”

when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. If the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed.

Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a

“concrete” result. Usually, this question arises when a result cannot be assured.

An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

4. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically:
5. In Claims 1-20, the ambiguities cited would make it impossible for the process to be repeatable or “concrete.” In other words, different users would come up with different responses.
6. As per Claims 1-20, it appears that the method/system is attempting to sell a matching service for professionals, whereas a match is dependent on independent criteria provided by the client. These independent criteria could contain a vast amount of different setting combinations – which would include different settings for each of the following: searchable keywords, the quality and quantity of candidate resume, and the type of

position advertisement. Thus, this method/system is not repeatable and would appear to be an attempt to patent an abstract idea not a "concrete" process.

7. Claims 1-20 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention lacks a patentable utility, for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claim 7 recites the limitation "at least one computer database" in the method of Claim 1.
There is insufficient antecedent basis for this limitation in the claim.
11. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.
See MPEP § 2172.01. The omitted elements are: the number of candidate screening queries to be associated with said position advertisement.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

13. Claims 1-3, 6-10, 15-16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas (US 2002/0055870 A1).

14. As per independent Claim 1, Thomas discloses a method of employment recruiting comprising the steps of: a) creating a position advertisement; b) storing said position advertisement in a computer searchable database; c) storing at least one search parameter including at least one keyword associated with said position advertisement in a computer searchable database; d) in response to a search parameter associated with said position advertisement, searching at least one computer searchable database for a candidate resume including said keyword; e) scoring said candidate resume as a function of said keyword; and f) presenting said candidate resume to a computer user as a function of said score (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17). Para 0004-0012 – resume imaging

15. As per Claim 2, Thomas discloses wherein the steps of scoring a candidate resume as a function of a keyword and presenting said candidate resume to a computer user as a function of said score comprises the steps of: a) identifying a number of occurrences of said keyword in said candidate resume; and b) presenting said candidate resume to said computer user if said number of said occurrences of said keyword in said candidate

resume at least equals a threshold number of said occurrences (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

16. As per Claim 3, Thomas discloses a) assigning a significance to said keyword; and b) influencing said scoring of said candidate resume as a function of said significance of said keyword (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).
17. As per Claim 6, Thomas discloses wherein the step of searching at least one computer searchable database in response to a search parameter associated with said position advertisement comprises the steps of: a) reading a first search parameter associated with said position advertisement specifying a periodicity of said search; b) reading a second search parameter associated with said position advertisement specifying a computer searchable database to be searched; and c) in response to said first search parameter initiating a search by a computer to said computer database identified by said second search parameter (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).
18. As per Claim 7, Thomas discloses wherein the step of searching at least one computer database in response to a search parameter associated with said position advertisement comprises the steps of: a) reading a first search parameter associated with said position advertisement specifying a periodicity of said search; b) reading a second search parameter associated with said position advertisement specifying a computer network accessible database to be searched; c) in response to said first search parameter accessing

said computer network accessible database with a computer; d) analyzing a text of a candidate resume (profile) stored in said computer network accessible database; e) scoring an occurrence of a keyword in said text of said candidate resume; and f) as a function of said scoring, copying said candidate resume to a candidate database (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

19. As per Claim 8, Thomas discloses wherein the step of creating a position advertisement comprises the steps of: a) accessing a position advertisement template, said template comprising of at least one candidate qualification entry; and b) including in a candidate qualification entry of said template no more than one candidate qualification (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

20. As per Claim 9, Thomas discloses identifying at least one keyword associated with a candidate qualification entry (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

21. As per Claim 10, Thomas discloses assigning significance to said keyword (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

22. As per independent Claim 15, Thomas discloses an employment recruiting system comprising: a) a searchable first data structure storing data associated with an employment position, said data including at least one search parameter including a

keyword; b) a searchable second data structure storing data related to a candidate for employment including a candidate resume; and c) a data processing device to search said second data structure for a candidate resume including said keyword, said search proceeding in response to a search parameter associated with said employment position (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

23. As per Claim 16, Thomas discloses a) a searchable third data structure accessible from a computer network for storing at least one candidate resume; and b) a network interface enabling said data processing device to search said third data structure for a candidate resume including said keyword (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

24. As per Claim 18, Thomas discloses wherein said data processing device comprises a resume scoring instruction to score said candidate resume as a function of an occurrence of a character string corresponding to said keyword (Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention

was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 4-5, 11, 13-14, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Dewar (US 2002/0055866 A1).
27. As per Claim 4, Thomas fails to disclose a) storing at least one candidate screening question associated with said position advertisement in a computer searchable database; b) requesting a response to said screening question from a candidate resume; and c) scoring said response to said screening question.
28. Dewar teaches a) storing at least one candidate screening question associated with said position advertisement in a computer searchable database; b) requesting a response to said screening question from a candidate resume; and c) scoring said response to said screening question (Abstract, Fig. 8, Para 0009, Para 0106, Para 0134, Claim 1).
29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a) storing at least one candidate screening question associated with said position advertisement in a computer searchable database; b) requesting a response to said screening question from a candidate resume; and c) scoring said response to said screening question, as disclosed by Barton in the system disclosed by Thomas, for the advantage of providing an employment system with the ability to further assess a candidate's capabilities by asking a job-related question and scoring it as part of the application process.
30. As per Claim 5, Thomas discloses a) assigning a significance to said response; and b) influencing said scoring of said response as a function of said significance of said response (Thomas: Abstract, Figs. 2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065,

Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17)
(Dewar: Abstract, Fig. 8, Para 0009, Para 0106, Para 0134, Claim1).

31. As per independent Claim 11, Thomas discloses a method of employment recruiting comprising the steps of: a) creating a position advertisement; b) associating with said position advertisement at least one search parameter including at least one keyword; c) storing said position advertisement in a computer searchable database; d) storing said at least one search parameter in a computer searchable database; e) in response to a search parameter, initiating a computer search of at least one computer searchable database for a candidate resume including said keyword; f) scoring said candidate resume as a function of said included keyword; g) including an identification of a candidate associated with said candidate resume in a search result to be presented to a computer user if said resume score of said candidate resume at least equals a threshold resume score; h) in response to said resume score, contacting said candidate and requesting a response to at least one screening question associated with said position advertisement; i) scoring a response of said candidate to said screening question; and j) reporting said screening question response score in a search result presented to said computer user (Thomas: Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17) (Dewar: Abstract, Fig. 8, Para 0009, Para 0106, Para 0134, Claim1).
32. As per Claim 13, Thomas discloses a) assigning a significance to said keyword; and b) influencing said candidate resume score as a function of significance of said keyword

(Thomas: Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

33. As per Claim 14, Thomas discloses repeating said search in response to a search periodicity specified in a search parameter associated with said position advertisement (Thomas: Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).
34. As per Claim 19, Thomas discloses wherein said data processing device comprises: a) a position advertisement template user interface including at least one candidate qualification entry; and b) a screening question template user interface comprising at least a candidate screening query to be associated with said position advertisement (Thomas: Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17) (Dewar: Abstract, Fig. 8, Para 0009, Para 0106, Para 0134, Claim1).
35. As per Claim 20, Thomas discloses wherein said resume scoring instruction comprises a screening query scoring instruction to score a response to said candidate screening query as a function of a significance weight associated with said screening query (Thomas: Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17) (Dewar: Abstract, Fig. 8, Para 0009, Para 0106, Para 0134, Claim1).
36. Claim 12 is rejected under 35 U.S.C. 103(a) as being obvious over Thomas.
37. As per Claim 12, Thomas does not distinctly disclose a) requesting said candidate approve contact with an employment reference; b) requesting a response of said

employment reference to at least one reference query; and c) reporting said response to said reference query in a search result presented to said computer user.

38. However, Thomas does teach the ability to perform a reference check (Abstract, Para 0468), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included requesting candidate approval, obtaining the reference, reporting the reference, and scoring the reference as part of a normal job application process.

39. Claim 17 is rejected under 35 U.S.C. 103(a) as being obvious over Thomas.

40. As per Claim 17, Thomas does not distinctly disclose wherein said data processing device comprises: a) a parser instruction to decompose said candidate resume to text; and b) a matching instruction to identify a character string corresponding to said keyword in said text.

41. However, Thomas does teach this technology and explain how his system is an improvement on said technology (Thomas: Abstract, Figs.2-6, Para 0004-0019, Para 0039-0046, Para 0059-0065, Para 0098-0102, Para 0268-0277, Para 0345-0360, Para 0451, Claims 1-3, Claims 8-17).

42. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a) a parser instruction to decompose said candidate resume to text; and b) a matching instruction to identify a character string corresponding to said keyword in said text in the system disclosed by Thomas, for the advantage of providing an employment system with the ability to scan resumes into the system, in order to provide a variety of data entry possibilities.

Conclusion

43. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

44. The following foreign patent is cited to show the best foreign prior art found by the examiner:

Japanese Pat. No. JP 11338881 A to Miyamoto et al.

Miyamoto discloses a job assignment management system for computer based job searching, estimates success/failure of particular candidate by combining the execution and job assignment values along with compatibility value.

45. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

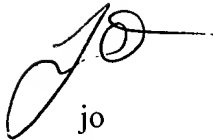
Parkes, Clara H., "Job-shopping Web-style: Web sites match companies and job seekers in ways previously impossible." DBMS, v10, n1, pS37(3), January 1997.

Parkes discloses several different ways web sites are matching employers with candidates.

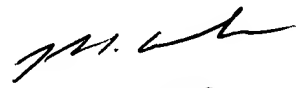
46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

48. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

A handwritten signature in black ink, appearing to be 'jo' followed by a stylized flourish.

jo
November 19, 2002

A handwritten signature in black ink, appearing to be 'John G. Weiss'.

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600